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wherein the program guide information is not displayed as it is received by said receiver while the user command to reserve the upcoming program for future recording is received.

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 16, 20, 24, 29, 37, 43, 46, 50-53, and 65 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 16-81 are pending and under consideration. Reconsideration is requested.

REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION

In the Office Action, the Examiner makes *Final* the rejection of claims 16-81 in light of Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) or Yuen et al. (U.S. Patent No. 6,091,884). However, Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) is not prior art under 35 U.S.C. §102(e) since the provisions of the American Inventors Protection Act which changed 35 U.S.C. §102(e) do not apply to the instant application. Specifically, the instant application was not filed on or after November 29, 2000 and was not voluntarily published.

As noted in MPEP 901.03, "the new prior art effects created by amended 35 U.S.C. 102(e) will *not be applicable to any application filed before November 29, 2000 and not voluntarily published*, nor a reexamination of a patent issued on such an application." The instant application was filed before November 29, 2000 and has not been voluntarily published. As such, even assuming *arguendo* Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) was voluntarily published, since the instant application was not voluntarily published, it is respectfully submitted that Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) is not prior art under 35 U.S.C. §102(e).

This interpretation of the applicability of 35 U.S.C. §102(e) is also consistent with the

Examiner's acknowledged on page 3 of the Office Action, in which the Examiner states that the "changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b)."

As such, the only remaining prior art which is applicable to the instant application is newly presented Yuen et al. (U.S. Patent No. 6,091,884). However, Yuen et al. (U.S. Patent No. 6,091,884) was not cited in the prior Office Action. Further, as no amendments to claims 16-53 were made and since the applicants were entitled to merely remove Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) from consideration without comment, the new application of Yuen et al. (U.S. Patent No. 6,091,884) represents a new rejection of claims 16-53 to which the Applicants have not had an opportunity to respond. Since the Applicants have not forwarded new prior art for consideration since the previous Office Action, and since the grounds for the new rejection are not necessitated by the Applicants' amendment of the claims, it is respectfully submitted that the Examiner's making final the rejection of claims 16-53 based upon newly presented prior art is improper. MPEP 706.07(a)&(c). Therefore, it is respectfully requested that the Examiner withdraw the finality of the rejection due at least to the improper use of the new grounds in the final rejection of claims 16-53. See, MPEP 706.07(d).

REJECTION UNDER 35 U.S.C. §102:

In the Office Action at pages 3-9, the Examiner rejects claims 16, 17, 19-26, 28-35, 37-54, 56-62, and 64-81 under 35 U.S.C. §102(e) in view of Yuen et al. (U.S. Patent Publication No. 2002/0012525A1). This rejection is respectfully traversed and reconsideration is requested.

As noted above, Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) is not available for use in a prior art rejection pursuant to the pre-AIPA version of 35 U.S.C. §102(e) since Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) is not a U.S. patent. As such,

the remaining analysis will be based upon the newly presented Yuen et al. (U.S. Patent No. 6,091,884).

Among other elements, the Examiner asserts on pages 4 and 7 of the Office Action that paragraph 507 of Yuen et al. (U.S. Patent Publication No. 2002/0012525A1) discloses an operation of receiving programming guide information without storing the program guide information. Similarly, the Examiner asserts on page 5 of the Office Action that paragraph 510 also discloses that the program guide information is not stored as it is received unless in response to a user command.

By way of review, Yuen et al. disclose a VBI decoder in an indexing VCR 10 which continuously decodes the channel specific program guide and temporarily stores it in RAM 33. (Col. 75, lines 10-19). The stored program guide can be used to program the VCR 10 using a PLUSCODE™ number, which is included in program related information (PRI) also temporarily stored in RAM 33. When a user selects the PRI, the VCR 10 recalls the stored PRI and programs the VCR 10 to record the program. However, if the PRI is not selected, the new PRI is stored in the RAM 33 according to a first-in, first-out (FIFO) method. (Col. 76, lines 37-62, col. 77, lines 8-37; FIG. 53). As such, Yuen et al. discloses continuously and temporarily storing PRI. However, Yuen et al. does not disclose that the PRI is received and not stored when the PRI is selected.

In contrast, claim 16 recites “receiving without storing program guide information associated with the upcoming program.” Claim 16 further recites “reserving, in response to the user command, the upcoming program for future recording using the received program guide information.” As such, it is respectfully submitted that Yuen et al. does not disclose or suggest the invention recited in claim 16.

Similarly, it is respectfully submitted that Yuen et al. does not disclose or suggest the invention recited in claims 20, 24, 29, 37, 43, 57, 78-80.

Further, Yuen et al. discloses storing multiple PRI temporarily until the temporary buffer is

full. When the temporary buffer is full, the new PRI overwrites the old PRI in the FIFO method as discussed above. As such, assuming a first PRI is broadcast during a commercial, the first PRI would exist after the commercial ends until sufficient new PRI are received to replace the first PRI. (Col. 76, lines 42-63 and FIG. 53). If the user wishes to retrieve the existing temporarily stored PRI, the user performs a retrieve operation to read the PRI stored in the temporary buffer. (FIGs. 53, operations 3724, 3725). However, there is no disclosure that the temporary buffer is cleared of PRI at the end of a program during which the PRI was transmitted, or that the PRI is otherwise inaccessible at the end of the program.

In contrast, claim 81 recites "receiving program guide information associated with the upcoming program, the program guide information being included with the program preview," "reserving, in response to the user command, the upcoming program for future recording using the received program guide information," "wherein said reserving the upcoming program is only operable while the program preview is being broadcast." As such, it is respectfully submitted that Yuen et al. does not disclose or suggest the invention recited in claim 81.

Additionally, Yuen et al. discloses storing multiple PRI, such as PLUSCODE™ numbers, while commercials are being broadcast using the indexing VCR 10 according to the method in FIG. 53. According to the method shown in FIG. 53, the PLUSCODE™ numbers are stored temporarily until the temporary buffer is full as discussed above. In order to access and store the PLUSCODE™ so as to program the indexing VCR 10, a review command is issued in operation 3724 and the user selects one of the displayed PLUSCODE™ numbers so as to program the VCR 10 in operation 3735 and 3736. (Col. 76, lines 20-3, col. 77, lines 8-45 and FIGs. 53 and 54). As shown in FIG. 54, the PLUSCODE™ numbers must be displayed in order to program the indexing VCR 10 using the PLUSCODE™ numbers.

In contrast, claim 46 recites, among other elements, "reserving, in response to the user command, the upcoming program for future recording using the received program guide information without the program guide information being displayed." As such, it is respectfully

submitted that Yuen et al. does not disclose the invention recited in claim 46, and similarly recited in claims 51, 53, and 65.

Yuen et al. further discloses that the indexing VCR 10 can be programmed through a single button, such as an i button. Where the i button is pressed twice, the review command is issued so as to display the stored PLUSCODE™ numbers. If the i button is pressed again, the record command is issued to program the indexing VCR 10. However, the use of the i button is disclosed in the context of operations 3724, 3735, and 3736 of the method of FIG. 53, whereby the display of the stored PLUSCODE™ numbers is required prior to programming the indexing VCR 10 to record a program. (Col. 77, lines 38-50 and FIG. 53). As such, in order to program the indexing VCR 10, the i button must be pressed three times: twice to display the stored PLUSCODE™ numbers, and once to program the indexing VCR.

In contrast, claim 50 recites “using a user input interface having user selection keys to generate a user command to reserve the upcoming program for future recording in accordance with a single action of one of the user selection keys being depressed to select and reserve the upcoming program.” As such, it is respectfully submitted that Yuen et al. does not disclose the invention recited in claim 50, and similarly recited in claims 23, 32, 44, 49, 52, 68, and 76.

Claims 17, 19, 21, 22, 25, 26, 28, 30, 31, 33-35, 38-40, 42, 43, 45, 47, 48, 54, 56, 58-62, 64, and 66, 67, 69-75, and 77 are deemed patentable due at least to their depending from corresponding claims 16, 24, 37, 46, 50, and 52.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 9-10, the Examiner rejected claims 18, 27, 36, 55, and 63 under 35 U.S.C. §103 in view of Yuen et al. and the Examiner's taking Official Notice of various elements. The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's taking Official Notice of the various elements is proper, the Examiner's taking Official Notice does not cure the above-noted defect

of Yuen et al. as applied to claims 16 and 24, from which claims 18, 27, 36, 55, and 63 correspondingly depend. Therefore, it is respectfully submitted that the combination of Yuen et al. and the Examiner's taking Official Notice does not disclose or suggest the invention recited in claims 16 and 24, claims 18, 27, 36, 55, and 63 remain patentable due at least to their depending from claims 16 and 24.

ATTACHMENT:

Attached hereto is a "Version With Markings to Show Changes Made," comprising a marked-up version of changes made to the Claims by the current amendment.

CONCLUSION:

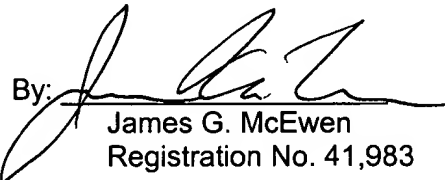
In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: OCT. 4, 2002

VERSION WITH MARKING TO SHOW CHANGES MADE

IN THE CLAIMS:

Please **AMEND** claims 16, 20, 24, 29, 37, 43, 46, 50-53, and 65, as follows. The remaining claims are reprinted, as a convenience to the Examiner, as they presently stand before the U.S. Patent and Trademark Office.

1-15. (PREVIOUSLY CANCELLED)

16. (ONCE AMENDED) A method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the method comprising:
receiving without storing program guide information associated with the upcoming program;

receiving, during the broadcast of the program preview, a user command to reserve the upcoming program for future recording; and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information.

17. (NOT AMENDED) The method of reserved recording in accordance with claim 16, wherein the program guide information is embedded in the program preview.

18. (NOT AMENDED) The method of reserved recording in accordance with claim 16, wherein the program preview comprises audio and video data in addition to the program guide information.

19. (NOT AMENDED) The method of reserved recording in accordance with claim 16, wherein said receiving the program guide information comprises automatically receiving the

program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information.

20. (ONCE AMENDED) The method of reserved recording in accordance with claim 16, wherein said [receiving] reserving the upcoming program comprises reserving the upcoming program without retrieving stored [the] program guide information from a memory [comprises receiving the program guide information without storing the program guide information].

21. (NOT AMENDED) The method of reserved recording in accordance with claim 16, further comprising prompting a user for the user command to reserve the upcoming program for future recording during the broadcast of the program preview.

22. (NOT AMENDED) The method of reserved recording in accordance with claim 16, further comprising providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed.

23. (NOT AMENDED) The method of reserved recording in accordance with claim 16, wherein the user command is generated in response to a single action of a user.

24. (ONCE AMENDED) A program recording device for reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the device comprising:

- a memory to store program guide information associated with the upcoming program;
- a user interface to receive, during the broadcast of the program preview, a user command to reserve the upcoming program for future recording; and
- a controller to reserve the upcoming program for future recording using the program

guide information,

wherein the program guide information is not stored in said memory until the user command is received.

25. (NOT AMENDED) The program recording device according to claim 24, further comprising a receiver to receive the program guide information.

26. (NOT AMENDED) The program recording device according to claim 24, wherein the program guide information is embedded in the program preview.

27. (NOT AMENDED) The program recording device according to claim 24, wherein the program preview comprises audio and video data in addition to the program guide information.

28. (NOT AMENDED) The program recording device according to claim 24, wherein the program guide information for the upcoming program to be broadcast at the future time is automatically received without another user command requesting the program guide information.

29. (ONCE AMENDED) The program recording device according to claim [24] 25, wherein the program guide information is not stored as it is received by said receiver unless in response to the user command to reserve the upcoming program for future recording.

30. (NOT AMENDED) The program recording device according to claim 24, wherein said controller further prompts a user for the user command during the broadcast of the program preview.

31. (NOT AMENDED) The program recording device according to claim 24, further comprising a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed.

32. (NOT AMENDED) The program recording device according to claim 24, wherein the user command is generated in response to a single action of a user.

33. (NOT AMENDED) The program recording device of claim 24, further comprising a recording unit that is operable to record the upcoming program in accordance with the program guide information stored in said memory.

34. (NOT AMENDED) The program recording device of claim 33, wherein said recording unit comprises a video cassette recorder.

35. (NOT AMENDED) The program recording device of claim 33, wherein said recording unit comprises a television having a recording unit.

36. (NOT AMENDED) The program recording device of claim 33, wherein said recording unit comprises a Hard Disc drive.

37. (ONCE AMENDED) A computer readable storage medium encoded with a computer program to implement a method of reserved recording of the upcoming program while a program preview for an upcoming program is being broadcast, the method comprising:

receiving without storing program guide information associated with the upcoming program;

receiving, during the broadcast of the program preview, a user command to reserve the

upcoming program for future recording; and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information.

38. (NOT AMENDED) The computer readable storage medium according to claim 37, wherein the program guide information is embedded in the program preview.

39. (NOT AMENDED) The computer readable storage medium according to claim 37, wherein the method further comprises prompting a user for the user command during the broadcast of the program preview.

40. (NOT AMENDED) The computer readable storage medium according to claim 37, wherein

said receiving the user command comprises detecting an input from a user input interface having user selection keys, and

the user command is generated in response to only one of the user selection keys being depressed.

41. (NOT AMENDED) The computer readable storage medium according to claim 37, wherein the program preview comprises audio and video data in addition to the program guide information.

42. (NOT AMENDED) The computer readable storage medium according to claim 37, wherein said receiving the program guide information comprises automatically receiving the program guide information for the program to be broadcast at the future time without another user command requesting the program guide information.

43. (ONCE AMENDED) The computer readable storage medium in accordance with claim 37, wherein said [receiving] reserving the upcoming program comprises reserving the upcoming program without retrieving stored [the] program guide information from a memory [comprises receiving the program guide information without storing the program guide information].

44. (NOT AMENDED) The computer readable storage medium in accordance with claim 37, wherein the user command is generated in response to a single action of a user.

45. (NOT AMENDED) The computer readable storage medium in accordance with claim 44, the method further comprising recording the upcoming program in accordance with the program guide information.

46. (ONCE AMENDED) A method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the method comprising:
receiving the program preview including program guide information associated with the upcoming program;

displaying the program preview;

receiving, during said displaying the program preview, a user command to reserve the upcoming program for future recording while the program guide information is being received;
and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information without the program guide information being displayed.

47. (NOT AMENDED) The method of reserved recording in accordance with claim 46, further comprising:

receiving a plurality of program previews for a plurality of upcoming programs; and

storing the plurality of program previews;

wherein said displaying the program preview comprises sequentially replaying the stored plurality of program previews.

48. (NOT AMENDED) The method of reserved recording in accordance with claim 47, further comprising providing a user input interface having user selection keys, wherein the user command is generated in accordance with a single one of the user selection keys being depressed.

49. (NOT AMENDED) The method of reserved recording in accordance with claim 46, wherein the user command is generated in response to a single action of a user.

50. (ONCE AMENDED) A method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the method comprising:

receiving program guide information associated with the upcoming program;

using a user input interface having user selection keys to generate a user command to reserve the upcoming program for future recording in accordance with a single action of one of the user selection keys being depressed to select and reserve the upcoming program; and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information.

51. (ONCE AMENDED) The method of reserved recording in accordance with claim 50, wherein the user command is generated in response to [a] the single action of a user while

the program guide information is not displayed.

52. (ONCE AMENDED) A computer readable storage medium encoded with a computer program to implement a method of reserved recording of the upcoming program while a program preview for the upcoming program is being broadcast, the method comprising:

receiving program guide information associated with the upcoming program;

receiving a user command from a user input interface having user selection keys, where the user input interface generates, during the broadcast of the program preview, the user command to reserve the upcoming program for future recording in accordance with a single action of one of the user selection keys being depressed to select and reserve the upcoming program; and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information.

53. (ONCE AMENDED) The computer readable medium in accordance with claim 52, wherein the user command is generated in response to [a] the single action of a user while the program guide information is not displayed.

54. (NOT AMENDED) The method of reserved recording in accordance with claim 20, wherein the program guide information is embedded in the program preview.

55. (NOT AMENDED) The method of reserved recording in accordance with claim 20, wherein the program preview comprises audio and video data in addition to the program guide information.

56. (NOT AMENDED) The method of reserved recording in accordance with claim

20, wherein said receiving the program guide information comprises automatically receiving the program guide information for the upcoming program to be broadcast at the future time without another user command requesting the program guide information.

57. (NOT AMENDED) The method of reserved recording in accordance with claim 20, wherein said reserving the upcoming program comprises reserving the upcoming program without retrieving stored program guide information from a memory.

58. (NOT AMENDED) The method of reserved recording in accordance with claim 20, further comprising prompting a user for the user command to reserve the upcoming program for future recording during the broadcast of the program preview.

59. (NOT AMENDED) The method of reserved recording in accordance with claim 20, further comprising providing a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed.

60. (NOT AMENDED) The method of reserved recording in accordance with claim 20, wherein the user command is generated in response to a single action of a user.

61. (NOT AMENDED) The program recording device according to claim 29, further comprising a receiver to receive the program guide information.

62. (NOT AMENDED) The program recording device according to claim 29, wherein the program guide information is embedded in the program preview.

63. (NOT AMENDED) The program recording device according to claim 29,

wherein the program preview comprises audio and video data in addition to the program guide information.

64. (NOT AMENDED) The program recording device according to claim 29, wherein the program guide information for the upcoming program to be broadcast at the future time is automatically received without another user command requesting the program guide information.

65. (ONCE AMENDED) The program recording device according to claim 61, wherein the program guide information is not [stored] displayed as it is received by said receiver [unless in response to] while the user command to reserve the upcoming program for future recording is received.

66. (NOT AMENDED) The program recording device according to claim 29, wherein said controller further prompts a user for the user command during the broadcast of the program preview.

67. (NOT AMENDED) The program recording device according to claim 29, further comprising a user input interface having user selection keys, wherein the user command is generated in response to only one of the user selection keys being depressed.

68. (NOT AMENDED) The program recording device according to claim 29, wherein the user command is generated in response to a single action of a user.

69. (NOT AMENDED) The program recording device of claim 29, further comprising a recording unit that is operable to record the upcoming program in accordance with

the program guide information stored in said memory.

70. (NOT AMENDED) The computer readable storage medium according to claim 43, wherein the program guide information is embedded in the program preview.

71. (NOT AMENDED) The computer readable storage medium according to claim 43, wherein the method further comprises prompting a user for the user command during the broadcast of the program preview.

72. (NOT AMENDED) The computer readable storage medium according to claim 43, wherein

said receiving the user command comprises detecting an input from a user input interface having user selection keys, and

the user command is generated in response to only one of the user selection keys being depressed.

73. (NOT AMENDED) The computer readable storage medium according to claim 43, wherein the program preview comprises audio and video data in addition to the program guide information.

74. (NOT AMENDED) The computer readable storage medium according to claim 43, wherein said receiving the program guide information comprises automatically receiving the program guide information for the program to be broadcast at the future time without another user command requesting the program guide information.

75. (NOT AMENDED) The computer readable storage medium in accordance with

claim 43, wherein said reserving the upcoming program comprises reserving the upcoming program without retrieving stored program guide information from a memory.

76. (NOT AMENDED) The computer readable storage medium in accordance with claim 43, wherein the user command is generated in response to a single action of a user.

77. (NOT AMENDED) The computer readable storage medium in accordance with claim 43, the method further comprising recording the upcoming program in accordance with the program guide information.

78. (NOT AMENDED) The method of reserved recording in accordance with claim 46, wherein the received program guide information is not stored unless the user command is received.

79. (NOT AMENDED) The method of reserved recording in accordance with claim 50, wherein the received program guide information is not stored unless the user command is received.

80. (NOT AMENDED) The computer readable medium in accordance with claim 52, wherein the received program guide information is not stored unless the user command is received.

81. (NOT AMENDED) A method of reserved recording of an upcoming program while a program preview for the upcoming program is being broadcast, the method comprising:
receiving program guide information associated with the upcoming program, the program guide information being included with the program preview;

receiving, during the broadcast of the program preview, a user command to reserve the upcoming program for future recording; and

reserving, in response to the user command, the upcoming program for future recording using the received program guide information,

wherein said reserving the upcoming program is only operable while the program preview is being broadcast.